REMARKS

U.S. patent application no. 09/091,134 ("the parent application") gave rise to U.S. Patent 6,613,319, which is the subject of this reissue application. This reissue application was filed to amend the specification such that it identified the application as a national stage entry under 371 of PCT/US97/14764. The PCT information, although acknowledged by the USPTO during prosecution of the parent application, was not recited on the cover page of the patent and applicants did not amend the parent applciation to refer to the PCT application. Thus one reading U.S. Patent No. 6,613,319 would perceive an apparent gap in the chain of priority back to the provisional application and it would appear that the U.S. 09/091,134 application was not filed within one year of the filing date of the provisional application.

Applicants' amendment to the specification of this reissue application recites:

> "This application is a [continuation in part] national stage application of International Application No. PCT/US97/14764, filed August 22, 1997, which claims the benefit of provisional U.S. Ser. No. 60/024,511, filed [Aug.] August 23, 1996, the disclosures of which [is] are incorporated herein by reference.

Thus the amendment to the specification corrects the USTPO omission of the PCT information, clarifies the priority claim to the provisional application and clearly establishes the chain of priority.

The Examiner contends that the reissue declaration filed in this application is defective because the error which is relied upon to support the reissue application is not an error upon which a reissue can be based. In particular, the Examiner states:

> "...there is no requirement to include reference to the application's 371 status in the first sentence of the specification. Thus the absence of such a statement does not represent a defect."
>
> (Office Action page 4)

As such, Applicants hereby abandon this reissue application. However Applicants disagree with the Examiner's additional statements relating to the priority claim in this application:

> "The proposed changes to the priority claim are not a proper error for reissue because they do not represent a defect in the issued

> patent. While Applicants may regret claiming priority to their provisional application under 35 U.S.C. 120 rather thatn 35 U.S.C. 119(e), it is not a defect and therefore cannot be corrected via a reissue application."
>
> (Office Action, page 3)

Applicants are not changing the priority claim to the provisional application, applicants' amendment clarifies the priority claim. It is and always has been applicants' intent to claim the priority of the provisional application under 35 U.S.C. 119(e). Applicants identified the provisional application by its serial no. and filing date and identified it as a provisional application during the pendency of the parent application. Applicants did not identify the priority claim to the provisional application as one under 35 U.S.C. 120. Nor did the USPTO during prosecution of the parent application recognize the priority claim as a claim under 120. None of the Office Actions in the parent application indicate that the USPTO ever considered the claim for priority to the provisional application to be a priority claim under 35 U.S.C. 120. The cover page of the issued patent under "Related U.S. Applications Data" recites: "[60] Provisional application no. 60/024,511, filed on Aug. 23, 1996". Thus the cover page of the issued patent, as does applicants' amendment, omits the "continuation-in-part" language, which eliminates the source of confusion.

The Examiner in this application misquoted MPEP § 201.11, subsection B in his comment:

> "By specifying a relationship (i.e. continuation in part) to the prior provisional application, the national stage application claimed benefit under 35 U.S.C. § 120. MPEP § 201.11, subsection B indicates that when a relationship between a prior provisional and subsequent nonprovisional application is stated in making the priority claim, ***such is construed*** as a claim for benefit under 35 U.S.C. § 120 of the prior provisional and not a section 119(e) claim for benefit."
>
> (Office Action page 3)

MPEP 201.1, subsection B actually states:

> "The relationship (i.e., continuation, divisional, or continuation-in-part) is not required and should not be specified when a prior provisional application is being claimed under 35 U.S.C. 119(e). No relationship should be specified because whenever a priority

> claim to a provisional application under 35 U.S.C. 119(e) is made, it is implicit that the relationship is "nonprovisional application of a provisional application." If a relationship between a prior provisional application and the non-provisional application is submitted, ***it may be unclear*** whether the applicant wishes to claim the benefit of the filing date of the provisional application under 35 U.S.C. 119(e) or 120. Thus applications seeking to claim the priority to a provisional application under 35 U.S.C. 119(e) should not state that the application is a continuation of a provisional application or that the application claims 35 U.S.C. 120 benefit to a provisional application. (emphasis added)

Applicants note that MPEP 201.11, subsection B states that the relationship, i.e., continuation, divisional, or continuation-in-part, "*should not*" be specified when a prior provisional application is being claimed under 35 U.S.C. 119(e) because it "*may be unclear*" whether the applicant wishes to claim the benefit of the filing date of the provisional application under 35 U.S.C. 119(e) or 120. The passage *does not state* a relationship *must not* be specified, but rather "should not" be specified. As such MPEP 201.11, subsection B does not preclude the recitation of a relationship (i.e., continuation, divisional, or continuation-in-part) when a prior provisional application is being claimed under 35 U.S.C. 119(e).

As MPEP 201.11 predicted, the Examiner has misunderstood applicants' intent to claim priority to the provisional application under 119(e) and erroneously concludes that the relationship specified in the first line of the application must be construed as a priority claim under 120 rather than under 35 U.S.C. 119(e).

The Examiner also comments:

> "It is further noted that 35 U.S.C. § 119(e)(I) requires that a claim for priority under §119(e) must be filed 'during pendency of the application.' Thus since the [parent] application issued as a patent on September 2, 2003, Applicant is now barred from filing a priority claim under § 119(e)."
>
> (Office Action page 3)

Applicants assert that the claim for priority to the provisional application under § 119(e) had been made in the parent application and was made during the pendency of the parent application. Upon entering national stage applicants amended the first line of the parent application to contain a specific reference to the earlier filed provisional application. Thus the amendment containing a

specific reference to the earlier filed provisional application was submitted at such time during the pendency of the application as is required by 35 U.S.C. 119(e).

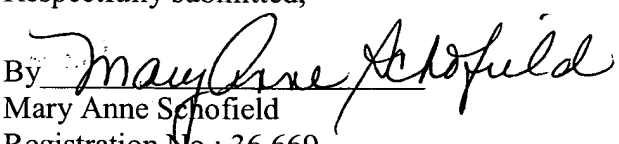
> "No application shall be entitled to the benefit of an earlier filed provisional application under this subsection unless an amendment containing the specific reference to the earlier filed provisional application is submitted at such time during the pendency of the application as required by the Director. The Director may consider the failure to submit such an amendment within that time period as a waiver of any benefit under this subsection. The Director may establish procedures including the payment of a surcharge to accept an unintentionally delayed submission of an amendment under this section during the pendency of the application."
>
> 35 U.S.C. 119(e)

Applicants' priority claim to the earlier filed U.S. Provisional application in the parent application is and was always intended to be a claim for priority under 35 U.S.C. 119(e). The foregoing demonstrates that applicants complied with the requirements of 35 U.S.C. 119(e) and MPEP 201.11, subsection B in the parent application.

Applicants believe no fee or request for extension of time are due with this filing. However, if such a fee is due or a request for an extension of time is required applicants authorize the Commissioner to deduct any missing or insufficient fee from Deposit Account No. 06-2375, under Order No. BSX 302-US1-REI/10408803 and applicants request that any necessary extensions of time be granted.

Dated: February 16, 2005

Respectfully submitted,

By 

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